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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197005
Party	Defendant Pan Am World Airways, Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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Attachments	Applicant's Motion to Dismiss Opposer's Amended Notice of Opposition.pdf (9 pages)(282134 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 77/931,658
For the Mark PAN AM & Design

_____)	
Gold Rush Brands, LLC,)	
)	
Opposer,)	
)	
v.)	Opposition No.:91/197,005
)	
)	
Pan Am World Airways, Inc.,)	
)	
Applicant.)	
_____)	

APPLICANT’S MOTION TO DISMISS OPPOSER’S AMENDED NOTICE OF OPPOSITION

Pursuant to Federal Rule of Civil Procedure 12(b)(6) and Section 503 of the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), and in lieu of an answer to Gold Rush Brands, LLC (“Opposer”)’s amended notice of opposition, Pan Am World Airways, Inc. (“Applicant”), by and through its undersigned counsel, respectfully requests that the Trademark Trial and Appellate Board (“Board”) dismiss the amended notice of opposition with prejudice for failure to state a claim upon which relief can be granted.

In support of said Motion, Applicant states as follows.

BACKGROUND

On February 9, 2010, Applicant filed application no. 77/931,658, for the mark “PAN AM” and design on an intent-to-use basis under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), for air transportation of passengers and freight in International Class 039 (“Pan Am application”). On February 19, 2010, ten (10) days after Applicant filed its application, Opposer filed an application for the mark “PAN AM” & Design also for use in connection with “transportation of goods, passengers and travelers by air” in International Class 039.

On June 22, 2010, the Pan Am application was published for opposition in the *Official Gazette*. Opposer filed its notice of opposition on October 20, 2010 alleging deceptiveness under section 2(a), 15 U.S.C. § 1052(a) of the Trademark Act and fraud on the United States Patent and Trademark Office (“PTO”). Applicant admittedly committed a clerical error in its application in using the name “Pan Am World Airways, Inc.” as opposed to its proper legal name “Pan American World Airways, Inc.” Based wholly on this clerical error, opposer filed its notice of opposition.

On November 24, 2010, applicant filed a motion to amend its application seeking to rectify the aforementioned clerical error. Opposer refused to assent to applicant’s proposed amendment and filed its opposition to the motion to amend on December 14, 2010.

In an order issued on December 12, 2011, the Board deferred the decision on the amendment until final decision or until the case is decided on summary judgment. The Board also noted that after review of opposer’s notice of opposition it “determined that [the opposition] does not properly allege either fraud or deceptiveness.” *See Order* dated December 12, 2011 at pg. 2. Thus, the Board permitted opposer to submit an amended notice of opposition that

properly alleges fraud and/or deceptiveness as a ground of for opposing the subject application.

Id. at pg. 6. Opposer filed its amended notice of opposition on December 27, 2011.

PRELIMINARY STATEMENT

Opposer disregarded the Board's specific instruction to amend its notice of opposition to properly allege fraud and/or deceptiveness. Opposer makes absolutely no mention of either allegation in its amended notice. Instead, opposer now seeks to disguise repetitious assertions regarding applicant's non-ownership of the mark as its new, "sole" ground for opposition. Opposer has failed to follow basic instructions and is using its opportunity to amend to provide further arguments in support of its opposition to applicant's requested amendment.

Opposer has now failed twice to properly plead, despite the Board's specific directions and its generous grant of leave for it to try again. Opposer has wasted over a year of both applicant's and the Board's time disposing of its fruitless allegations of fraud and deceptiveness, which have conveniently disappeared from its amended pleading. Opposer has exhausted both its opportunities to plead and its avenues of delay and its amended notice of opposition should be dismissed with prejudice.

ARGUMENT

I. Legal Standard for Motion to Dismiss

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of the complaint. *See Libertyville Saddle Shop, Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594 (TTAB 1992). In order to withstand such a motion, a pleading need only allege such facts as would, if proved, establish that (1) that the plaintiff has standing to

maintain the proceeding, and (2) that a valid ground exists for denying the registration sought. *See Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024 (1982). Standing and grounds for opposition are separate elements, and the opposition must provide enough detail to give the applicant fair notice of each. *Young v. AGB Corp.*, 152 F.3d 1377, 1378, 47 USPQ2d 1752 (Fed Cir. 1998); *McDonnell Douglas Corp. v. National Data Corp.*, 228 U.S.P.Q. 45, 47 (TTAB 1985). The Board's reviewing court has determined that the "valid ground" for denying registration that must be alleged and ultimately proved must be a "statutory ground which negates the appellant's right to the subject registration." *Young, supra*, at 1754.

In determining whether or not a litigant before the Board has stated a claim upon which relief can be granted, it "must assume that the facts alleged in the petition are true." *Stanspec Co. v. American Chain & Cable Co.*, 531 F.2d 563, 566, 189 U.S.P.Q. (BNA) 420, 422 (CCPA 1976). Dismissal is appropriate only if it appears certain that the opposer is entitled to no relief under any set of facts which could be proved in support of its claim. *Id.*

II. Opposer Fails to State a Viable Claim to Deny Applicant's Trademark Registration

Opposer fails to identify any proper or intelligible grounds for its opposition. Instead it invites the Board to refuse registration on the grounds that applicant is not now and was not the true owner of the mark at the time of its application and no valid grounds exist for amending the application. *See Opposer's Amended Notice of Opposition* ¶ 9. However, the determination of this issue is properly suited for disposition on applicant's motion to amend and is merely a strategy to further delay applicant's registration.

After its first failed attempt at meeting the low threshold of properly pleading its claim, opposer was permitted to submit an amended notice of opposition. The Board was very specific in allowing an amended opposition “that properly alleges fraud and/or deceptiveness as a ground for opposing registration of the subject application, failing which, the opposition may be dismissed for opposer’s failure to state a claim upon which relief can be granted.” *See Order* at pg. 6. However, opposer blatantly disregards the Board’s instructions and effectively abandons its original allegations as it makes no mention of either in its amended notice of opposition. Realizing that it had no basis for its allegations of deceptiveness or fraud it now seeks to hang its hat on its assertion that applicant is not and was not the true owner of the mark and no valid grounds exist to amend. This issue of ownership, based on applicant’s clerical error, was conceded to by applicant from inception and is not a statutory basis for opposition. Further, opposer had its chance to argue against applicant’s amendment and it should not be permitted to use its amended notice to take another bite at the apple.

Opposer continues to insist that the Board allow this case to proceed to discovery so that the veracity of counsel’s representations is tested. However, opposer has failed to produce, even upon allowance by the Board of an amended notice, any valid allegation that supports a denial. Opposer saw an avenue through which to oppose, applicant’s clerical error, and after two lackluster attempts at pleading its claims, it has failed. Opposer should no longer be permitted to capitalize on judicial resources to further delay applicant’s registration and waste the Board’s time.

The cases provided in support of applicant’s “sole” ground for opposition are not only weak but at times actually supportive of the Board’s granting applicant’s amendment. In fact,

the first set of cases, which purportedly demonstrate circumstances requiring the Board's refusal to amend an application, were cited to in opposer's opposition to applicant's motion to amend. In *In re Tong Yang Cement Corp.*, the Board denied the amendment because the rightful owner of the mark was a joint venture, and the applicant wrongly named one of the entities of the joint venture as owner as opposed to the joint venture itself. *In re Tong Yang Cement Corp.*, 19 U.S.P.Q.2d 1689 (TTAB 1991). In *In re Eucryl Ltd.*, the Board refused to permit an amendment where the applicant was the exclusive domestic distributor of a foreign manufacturer and applicant could not show an agreement evidencing that the foreign manufacturer, as rightful owner, permitted the application. *In re Eucryl Ltd.*, 193 U.S.P.Q. 2d 581 (TTAB 1976). However, the Board in *Eucryl* noted that "the situation here differs from those in which there was a mere misidentification of the party who made application for registration. In those situations, title always vested in the same entity and applicant was permitted to correct the misidentification." *Id.* at FN1. *cf. Argo & Company, Inc. v. Springer, et al.*, 189 USPQ 581 (TT&A Bd., 1976); *Outdoor Sports Industries, Inc. v. The Joseph & Feiss Company*, 177 USPQ 533 (Comr., 1973). The circumstances in *Tong Yan* and *Eucryl* are clearly distinguishable from the facts of this case. Here, title to the mark vested only in one entity, an entity that was mistakenly abbreviated, and as case law suggests applicant should be permitted to amend. Again, however, these arguments are properly suited for opposition to the amendment not as a basis for opposition.

The other cases cited in support of this actually support applicant's amendment. In *In re Techsonic Industries, Inc.*, a proposed amendment changing the way the owner had been identified was permitted because the owner had been incorrectly identified in the original application. The Board noted that although there were two errors in its application, "throughout

the entire procedure there has been only one a single entity involved and at all times that entity has been the owner of the mark.” *In re Techsonic Industries, Inc.*, 216 USPQ 619, 620 (TTAB 1982). In *In re Atlanta Blue Print Co.*, applicant incorrectly used its trade name instead of its legal name on the application. The Board found that the Examiner clearly erred in refusing the applicant’s requested amendment, noting that the situation is analogous to instances where applications are filed in which the name of the application is incorrectly set out “using its alternative name under which it does business rather than its legal corporate name.” *In re Atlanta Blue Print Co.*, 19 U.S.P.Q.2d 1078, 1079 (Comm’r 1990); *see also* TMEP § 1201.01(b). Not only in these cases were the amendments allowed, but the circumstances are similar to the facts of this case.

Opposer goes on to cite cases that allegedly support its allegation that because applicant is not the true owner, the application should be *voided ab initio*. In two of the three cases cited in support thereof, the Board actually concluded that it was without authority to resolve the issue of ownership as a result of the subject registrations being more than five (5) years old. *Kemin Industries, Inc. v. Watkins Products, Inc.*, 192 USPQ 327, 329 (TTAB 1976); *Treadwell’s Drifters Inc. v. Marshak*, 18 USPQ 1318, 1320 (TTAB 1990). The third case, *Anheuser Busch Inc. v. The Florists Association of Greater Cleveland Inc.*, deals with an applicant that sought registration of a famous mark owned by Anheuser Busch, Inc., in a class of goods that the mark was not previously registered. *See Anheuser Busch Inc. v. The Florists Association of Greater Cleveland Inc.*, 29 USPQ2d 1146 (TTAB 1993). The Board denied registration citing a number of issues; including likelihood of confusion and that applicant was not the true owner of the mark. However, in discussing the issue of ownership, the Board noted that the applicant did not itself sell the goods for which it applied for trademark protection. It had no control over the

goods and there were no license agreements in place with the individual retailers who actually sold the goods. *Id.* at 1150.

This is not a case where a joint venture exists or where there is another entity claiming to be the true applicant. It is simply an honest, inadvertent clerical error which applicant seeks to rectify. Opposer has been given every chance to plead proper allegations with which to support its opposition to no avail and should no longer be permitted to delay applicant's registration.

CONCLUSION

Based on the aforementioned reasons, applicant respectfully requests that the Board grant this motion and dismiss opposer's amended notice of opposition with prejudice.

Respectfully submitted,
Pan American World Airways, Inc.
By its attorneys



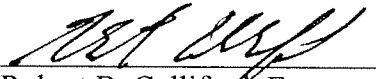
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Dated: January 17, 2012

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and accurate copy of this Applicant's Motion to Dismiss Opposer's Amended Notice of Opposition was served on this 17th day January, 2012 on the Opposer via first class mail and addressed to:

Edmund J. Ferdinand, III, Esq.
Jeffers Cowherd, P.C.
55 Walls Drive
Fairfield, CT 06824



Robert B. Culliford, Esq.